

REMARKS

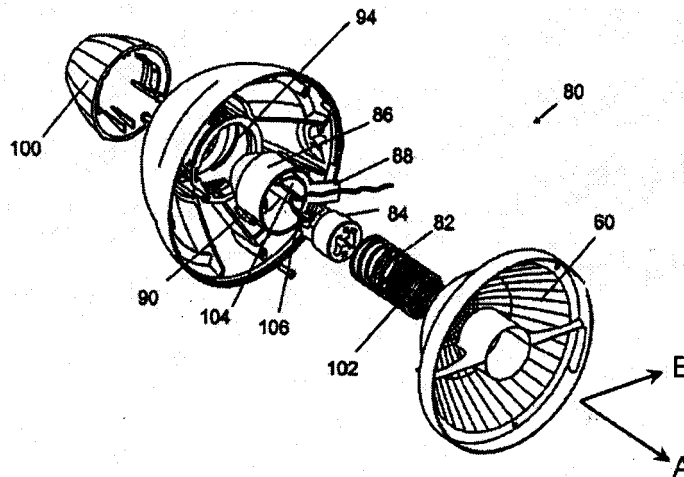
Claims 1-38 were previously pending in the present application. Claims 12-21, 34 and 36-38 are currently canceled without prejudice or disclaimer, and new claims 39-53 are currently added. Consequently, claims 1-11, 22-33, 35 and 39-53 are currently pending in the present application.

Reconsideration of the present application in light of the above amendments and the following remarks is respectfully requested.

Objections to the Drawings and Rejections under 35 U.S.C. §112

The Examiner has objected to the drawings and rejected several claims under 35 U.S.C. §112 because the claimed subject matter “one or more directional components directed generally radially outward from the axis of translation of the mounting cup” is allegedly not shown in the drawings or described in the specification. However, the specification is currently amended to include this claimed subject matter. Moreover, it is clear that Figs. 8-10 illustrate the claimed subject matter.

For example, in Fig. 9 repeated below, the wire guide tab 88 extends in a direction having a directional component A and a directional component B, where the directional component A is generally parallel with the axis of translation of the mounting cup 86, and where the directional component B is generally radially outward from the axis of translation of the mounting cup 86.



Rejections under 35 U.S.C. §102**Claim 11**

Claim 11 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 999,860 to Perry, et al. ("Perry").

The PTO provides in MPEP §2131 that:

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, to sustain this rejection with respect to claim 11, Perry must contain all of the above claimed elements of the claim. However, in the context of claim 11, Perry does not disclose a wire guide wall arranged at least partially in a mounting cup for anchoring one or more wires to the mounting cup, wherein the one or more wires are sandwiched between an inside surface of the wire guide wall and an outside surface of the socket, among other elements of claim 11.

The Examiner alleges that Perry discloses a socket (provided within the sleeve 6), a mounting cup (the sleeve 6), a wire guide wall (the rib or fin 7), and one or more wires (the conductors 16) extending from the socket. However, the rib 7 is for engaging with a slot in the flange 25 to prevent rotation of the sleeve 6 relative to the flange 25 and reflector 4. (Page 1, right column, lines 75-82). Thus, the rib is not a wire guide wall for anchoring one or more wires to the sleeve 6, as alleged by the Examiner. Moreover, the wires 16 are not sandwiched between an inside surface of the rib 7 and an outside surface of the socket of sleeve 6. In contrast, the wires 16 are attached to the socket with threaded fasteners, as shown in Fig. 1, and Perry is otherwise silent as to whether the wires 16 are sandwiched between the rib 7 and the socket of sleeve 6.

Accordingly, the §102 rejection of claim 11 is not supported by Perry. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Claim 33

Claim 33 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,280,320 to Beaton, et al. ("Beaton"). However, as provided above, to sustain this rejection with respect to claim 33, Beaton must contain all of the above claimed elements of the claim. However, in the context of claim 33, Beaton does not disclose a helical spring having at least a portion with a closed pitch for blocking light from the lamp, among other elements of claim 33.

The Examiner alleges that Beaton discloses a helical spring 29, at least a portion of which has a closed pitch. However, as clearly shown in Fig. 1, the helical spring 29 of Beaton does not include a portion having a closed pitch. In contrast, the helical spring 29 has an open pitch, as evident in the gaps between each neighboring pair of turns.

Accordingly, the §102 rejection of claim 33 is not supported by Beaton. Consequently, Applicants respectfully request the Examiner withdraw the rejection.

Rejections Under 35 U.S.C. §103: Perry in view of StearnsClaim 1

Claims 1, 2 and 24-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perry in view of U.S. Patent No. 1,115,033 to Stearns ("Stearns"). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 1.

As the PTO recognizes in MPEP §2142:

... The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for the following, mutually exclusive, reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

As provided in 35 U.S.C. §103:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Among other elements of claim 1, the Examiner concedes that Perry fails to disclose a wire guide tab extending in a direction directed radially outward from the axis of translation of the mounting cup.

The Examiner also alleges that Stearns discloses an electric lamp with a focus assembly having a wire guide tab 55 extending in a direction directed radially outward from the axis of translation of a mounting cup 36. However, member 55 is a retaining screw for securing the wire 41 to the terminal 40, in conjunction with the terminal screw 42. Thus, member 55 is not a wire guide tab in the context of claim 1 of the present application.

Consequently, Perry and Stearns, whether taken separately or together, fail to teach every element recited in claim 1. Therefore, it is impossible for the combination of Perry and Stearns to render obvious the subject matter of claim 1, as a whole, and the explicit terms of §103 cannot be met. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

2. The Combination of References is Improper

Assuming, arguendo, that the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why Perry and Stearns cannot be applied to reject claim 1 under 35 U.S.C. §103.

§2142 of the MPEP also provides:

...the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The Examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither Perry nor Stearns teaches, or even suggests, the desirability of the combination of a wire guide tab extending from a mounting cup in a direction comprising one or more directional components, wherein a directional component of the one or more directional components is directed generally radially outward from the axis of translation of the mounting cup, and wherein at least a portion of each of the one or more wires is positioned relative to the wire guide tab so that the one or more wires are shielded from the socket focusing mechanism during the axial translation of the mounting cup.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the Examiner's combination can arise solely from hindsight based on the present application, because there is no showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of

obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Claim 12

Claims 12 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perry in view of Stearns. However, these claims are currently canceled, thus rendering their rejection moot.

Claims 28 and 29

Claims 28 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perry in view of Stearns. However, claims 28 and 29 depend from claim 11. As described above, Perry fails to disclose a wire guide wall arranged at least partially in a mounting cup for anchoring one or more wires to the mounting cup, wherein the one or more wires are sandwiched between an inside surface of the wire guide wall and an outside surface of the socket, among other elements of claim 11. Moreover, Stearns fails to cure this shortcoming of Perry. That is, Stearns also fails to disclose a wire guide wall arranged at least partially in a mounting cup for anchoring one or more wires to the mounting cup, wherein the one or more wires are sandwiched between an inside surface of the wire guide wall and an outside surface of the socket, among other elements of claim 11. Consequently, the combination of Perry and Stearns fails to support a *prima facie* case of obviousness of claim 11 and its dependent claims (e.g., dependent claims 28 and 29). Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

Claim 32

Claim 32 was rejected under 35 U.S.C. §103(a) as being unpatentable over Perry in view of Stearns. However, as described above, Perry fails to disclose a wire guide wall arranged at least partially in a mounting cup for anchoring one or more wires to the mounting cup, wherein the one or more wires are sandwiched between an inside surface of the wire guide wall and an outside surface of the socket, among other elements of claim 32. Moreover, Stearns fails to cure

this shortcoming of Perry. That is, Stearns also fails to disclose a wire guide wall arranged at least partially in a mounting cup for anchoring one or more wires to the mounting cup, wherein the one or more wires are sandwiched between an inside surface of the wire guide wall and an outside surface of the socket, among other elements of claim 32.

Perry and Stearns also each fail to disclose a wire guide tab extending from the mounting cup in a direction comprising one or more directional components, wherein a directional component of the one or more directional components is directed generally radially outward from the axis of translation of the mounting cup, and wherein another directional component of the one or more directional components is directed axially away from the socket focusing mechanism. That is, neither reference discloses a wire guide tab in the context of claim 32, much less a wire guide tab extending from a mounting cup in a direction having a first directional component radially outward from the axis of translation of the mounting cup and a second directional component axially away from the socket focusing mechanism.

Consequently, the combination of Perry and Stearns fails to support a *prima facie* case of obviousness of claim 32. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

Claim 35

Claim 35 was rejected under 35 U.S.C. §103(a) as being unpatentable over Perry in view of Stearns. However, as described above, Perry and Stearns each fail to disclose shielding means tab extending from securing means in a direction having a first directional component radially outward from the axis of translation of the securing means and a second directional component axially away from the translating means, in the context of claim 35. Consequently, the combination of Perry and Stearns fails to support a *prima facie* case of obviousness of claim 35. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

Claims 37 and 38

Claims 37 and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perry in view of Stearns. However, these claims are currently canceled, thus rendering their rejection moot.

Rejections Under 35 U.S.C. §103: Perry in view of Stearns, Own and Bamber

Claims 3-10 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Perry in view of Stearns and further in view of U.S. Patent No. 5,735,594 to Own ("Own") and U.S. Patent No. 5,017,327 to Bamber ("Bamber"). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 1.

As described above, Perry and Stearns are defective in establishing a *prima facie* case of obviousness with respect to claim 1. Moreover, Own and Bamber fail to cure the shortcomings of Perry and Stearns. That is, like Perry and Stearns, Own and Bamber fail to teach or suggest a wire guide tab extending from a mounting cup in a direction comprising one or more directional components, wherein a directional component of the one or more directional components is directed generally radially outward from the axis of translation of the mounting cup, and wherein at least a portion of each of the one or more wires is positioned relative to the wire guide tab so that the one or more wires are shielded from the socket focusing mechanism during the axial translation of the mounting cup.

Consequently, whether taken separately or in combination, Perry, Stearns, Own and Bamber fail to teach every element recited in claim 1. Therefore, it is impossible for any combination of these references to render obvious the subject matter of claim 1, as a whole, and the explicit terms of §103 cannot be met. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

Rejections Under 35 U.S.C. §103: Beaton in view of Grosz**Claim 22**

Claim 22 was rejected under 35 U.S.C. §103(a) as being unpatentable over Beaton in view of U.S. Patent No. 2,802,094 to Grosz ("Grosz"). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 22.

As the PTO recognizes in MPEP §2142:

... The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for the following, mutually exclusive, reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

As provided in 35 U.S.C. §103:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither Beaton nor Grosz teaches or suggests a helical spring having at least a portion with a closed pitch.

The Examiner alleges that Beaton discloses a helical spring 29, at least a portion of which has a closed pitch. However, as clearly shown in Fig. 1, the helical spring 29 of Beaton does not

include a portion having a closed pitch. In direct contrast, the entire length of the helical spring 29 has an open pitch.

Consequently, Beaton and Grosz, whether taken separately or together, fail to teach every element recited in claim 22. Therefore, it is impossible for the combination of Beaton and Grosz to render obvious the subject matter of claim 22, as a whole, and the explicit terms of §103 cannot be met. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

2. The Combination of References is Improper

Assuming, arguendo, that the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why Beaton and Grosz cannot be applied to reject claim 22 under 35 U.S.C. §103.

§2142 of the MPEP also provides:

...the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The Examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither Beaton nor Grosz teaches, or even suggests, the desirability of combination to arrive at an apparatus comprising a helical spring where at least a portion of the helical spring has a closed pitch, as recited in claim 22. Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of their combination to arrive at the recitation of present claim 22. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection of claim 22.

Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Rejections Under 35 U.S.C. §103: Beaton in view of Grosz, Buzalski and Scott

Claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over Beaton in view of Grosz and further in view of U.S. Patent No. 3,858,094 to Buzalski ("Buzalski") and U.S. Patent No. 6,741,033 to Scott, et al. ("Scott"). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 22.

As described above, Beaton and Grosz are defective in establishing a *prima facie* case of obviousness with respect to claim 22. Moreover, Buzalski and Scott fail to cure the shortcomings of Beaton and Grosz. That is, like Beaton and Grosz, Buzalski and Scott fail to teach or suggest a helical spring where at least a portion of the helical spring has a closed pitch.

Consequently, whether taken separately or in combination, Beaton, Grosz, Buzalski and Scott fail to teach every element recited in claim 22. Therefore, it is impossible for any combination of these references to render obvious the subject matter of claim 22, as a whole, and the explicit terms of §103 cannot be met with respect to claim 22 or its dependent claims (e.g., claim 23). Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

New Claim 39

It is also believed that new claim 39 is patentable over the art of record because, whether taken separately or together, the cited prior art references fail to teach or suggest the specific combination of:

- means for receiving a lamp, the lamp receiving means having a wire extending therefrom;
- means for securing the lamp receiving means to a luminaire;
- means for translating the securing means axially relative to a stationary reflector, the translating means comprising:
 - a mounting cup receptacle;
 - a cam arranged on the securing means; and
 - means for engaging the cam arranged on the mounting cup receptacle; and
- means for shielding the wire from the translating means during translation of the securing means, wherein the wire shielding means extends from the securing means in a direction having at least one directional component that is generally radially outward from the axis of translation of the securing means.

New Claim 45

It is also believed that new claim 45 is patentable over the art of record because, whether taken separately or together, the cited prior art references fail to teach or suggest the specific combination of:

- means for receiving a lamp, the lamp receiving means having a wire extending therefrom;
- means for securing the lamp receiving means to a luminaire;
- means for translating the securing means axially relative to a stationary reflector, the translating means comprising:
 - a mounting cup receptacle;
 - a cam arranged on the mounting cup receptacle; and
 - means for engaging the cam arranged on the securing means; and
- means for shielding the wire from the translating means during translation of the securing means, wherein the wire shielding means extends from the securing means in a direction having at least one directional component that is generally radially outward from the axis of translation of the securing means.

New Claim 51

It is also believed that new claim 51 is patentable over the art of record because, whether taken separately or together, the cited prior art references fail to teach or suggest the specific combination of:

- means for receiving a lamp, the lamp receiving means having a wire extending therefrom;
- means for securing the lamp receiving means to a luminaire;
- means for translating the securing means axially relative to a reflector;
- means for resisting relative rotation between the securing means and the lamp receiving means; and
- means for shielding the wire from the translating means during translation of the securing means.

New Claim 52

It is also believed that new claim 52 is patentable over the art of record because, whether taken separately or together, the cited prior art references fail to teach or suggest the specific combination of:

- providing a socket having a wire extending therefrom;
- securing the socket at least partially inside a mounting cup such that the mounting cup and socket are axially translatable relative to the reflector but not rotatable relative to each other;
- anchoring the wire to the mounting cup such that the wire is shielded from contact during axial translation of the mounting cup relative to the reflector; and
- installing a lamp in the socket.

New Claim 53

It is also believed that new claim 53 is patentable over the art of record because, whether taken separately or together, the cited prior art references fail to teach or suggest the specific combination of:

- providing a luminaire comprising:
- a mounting cup;
- a socket arranged at least partially inside the mounting cup such that the mounting cup and socket are axially translatable relative to the reflector but not rotatable relative to each other;
- a wire extending from the socket and anchored to the mounting cup;
- a wire guide tab configured to shield the wire from contact during axial translation of the mounting cup and socket relative to the reflector; and
- a lamp installed in the socket; and
- axially translating the mounting cup and socket relative to the reflector by rotating the mounting cup and socket relative to the reflector.

Conclusion

All matters set forth in the Office Action have been addressed. Accordingly, it is believed that all claims are in condition for allowance. Favorable consideration and an early indication of allowability are respectfully requested.

Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



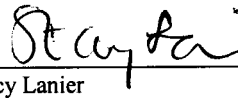
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Stacy Lanier